



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Anja KLEIN ET AL.

Serial No. 09/530,386

Group Art Unit: 2684

Confirmation No. 7374

Filed: April 27, 2000

Examiner: Nguyen, Tu X

For: METHOD, MOBILE STATION AND BASE STATION FOR CONNECTION SETUP IN A
RADIO COMMUNICATION SYSTEM

APPEAL REINSTATEMENT REQUEST AND

SUPPLEMENTAL APPEAL BRIEF UNDER 37 C.F.R. §1.193(b)(2)

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to the Appellant's Notice of Appeal, filed on July 30, 2004, Appellant's Appeal Brief, filed July 30, 2004, and the Examiner's apparent reopening of prosecution in the Office Action mailed October 22, 2004, Appellant hereby requests reinstatement of the Appeal to the Board of Patent Appeals and Interferences.

This Supplemental Appeal Brief is also respectfully submitted, briefly discussing the additional argument presented by the Examiner in the Office Action mailed October 22, 2004. As the response due date for the Office Action was January 22, 2004, a petition for a one-month extension of time has been concurrently filed herewith, thereby extending the response due date to February 22, 2004.

In conformance with requirements set forth in 37 CFR §1.192(c), the Appeal Brief filed July 30, 2004 is incorporated herein by reference.

Appellant submits this Supplemental Appeal Brief in triplicate.

I. Status of Claims

Pursuant to 37 C.F.R. §1.192(c)(3), claims 18-21 and 24-35 are pending and under consideration at the filing of this Supplemental Appeal Brief.

The Office Action issued October 22, 2004, indicates that claims 22 and 23 are withdrawn from consideration, but remain pending. However, it is noted that claim 22 was canceled in the Amendment filed July 30, 2004, and claim 23 was canceled in the Amendment filed October 30, 2002.

II. Status of Amendments

Pursuant to 37 C.F.R. §1.192(c)(4), pending claims 18-21 and 24-34 were amended with Amendment filed July 30, 2004, with claim 22 being canceled. Pursuant to 37 C.F.R. §1.192(c)(9), a copy of the pending claims was previously included in the Appendix of the Appeal Brief filed July 30, 2004.

III. Argument

As recited on page 6 of the Appeal Brief filed July 30, 2004:

“Further, as independent claims 18, 33 and 34 include the feature of the signal transmitted in the downstream direction is a pilot signal, it is noted that to disclose this feature the Examiner has merely relied upon Hayashi et al. [, U.S. Patent No. 6,069,884,] as disclosing the same. Thus, without any obviousness analysis, the Examiner, in the previous rejection of claim 22, merely added that feature to the aforementioned combination of Jolma et al., [U.S. Patent No. 5,806,003,] Gardner et al., [U.S. Patent No. 5,729,557,] and Hayashi et al., and the Examiner would presumably similarly argue [] the addition of this feature to the combination of Jolma et al., Gardner et al., Hayashi et al., and Oberholtzer [, U.S. Patent No. 5,465,399,] without analysis, merely because the argument for adding the previous feature of Hayashi et al. has been made, i.e., no obviousness argument has been made for the addition of the pilot signal feature since the Examiner appears to believe it not necessary with a previous feature of Hayashi et al. having already been combined with Jolma et al. and Gardner et al.”

Accordingly, the outstanding Office Action is nearly identical to the previous Office Action issued March 30, 2004, for which the Appeal Brief filed July 30, 2004, addresses in full. The only substantive difference between the outstanding Office Action and that of the Office Action mailed March 30, 2004 would appear to be the addition of two phrases on page 3, lines 14 and 17, of the outstanding Office Action, where the Examiner merely adds that Jolma et al. fails to

disclose "wherein the signal transmitted in the downstream direction is a pilot signal," and that Hayashi et al. discloses "wherein the signal transmitted in the downstream direction is a pilot signal," respectively.

Thus, the outstanding Office Action's rationale for further modifying Jolma et al. has not changed, but merely incorporated the same into the previous rejection of the independent claims.

Accordingly, it is respectfully submitted that the Appeal Brief filed July 30, 2004 already sufficiently addresses the imperipness of this rejection and the lacking of a prima facie obviousness case for the same.

Reinstatement of the Appeal is respectfully requested.

IV. Conclusion

In view of the law and facts stated herein, the Appellant respectfully submits that the Examiner has failed set forth a prima facie obviousness case against the pending claims.

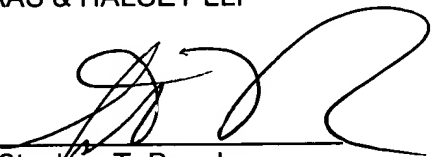
For all the foregoing reasons, including the reasons set forth in the Appeal Brief filed July 30, 2004, the Appellant respectfully submits that the cited prior art does not teach or suggest the presently claimed invention. The claims are patentable over the prior art of record and the Examiner's findings of unpatentability regarding claims 18-21 and 24-35 should be reversed and the patentability over the presently cited references be affirmed.

The Commissioner is hereby authorized to charge any additional fees required in connection with the filing of the Appeal Brief to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Dated: 2/22/05

By: 
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S&H Form: (12/04)

**REPLY/AMENDMENT
FEE TRANSMITTAL**

Attorney Docket No.	1454.1200
Application Number	09/530,386
Filing Date	April 27, 2000
First Named Inventor	Anja KLEIN ET AL.
Group Art Unit	2684
Examiner Name	Nguyen, Tu X

AMOUNT ENCLOSED

120.00

FEE CALCULATION (fees effective 12/08/04)

CLAIMS AS AMENDED	Claims Remaining After Amendment	Highest Number Previously Paid For	Number Extra	Rate	Calculations
TOTAL CLAIMS		- =	0	X \$ 50.00 =	\$ 0.00
INDEPENDENT CLAIMS		- =	0	X \$ 200.00 =	0.00
Since an Official Action set an <u>original</u> due date of <u>January 22, 2005</u> , petition is hereby made for an extension to cover the date this reply is filed for which the requisite fee is enclosed (1 month (\$120)); (2 months (\$450)); (3 months (\$1,020)); (4 months (\$1,590)); (5 months (\$2,160)):					120.00
If Notice of Appeal is enclosed, add (\$500.00)					
If Statutory Disclaimer under Rule 20(d) is enclosed, add fee (\$130.00)					
Information Disclosure Statement (Rule 1.17(p)) (\$180.00)					
Total of above Calculations =					\$ 120.00
Reduction by 50% for filing by small entity (37 CFR 1.9, 1.27 & 1.28)					
TOTAL FEES DUE =					\$ 120.00

(1) If entry (1) is less than entry (2), entry (3) is "0".

(2) If entry (2) is less than 20, change entry (2) to "20".

(4) If entry (4) is less than entry (5), entry (6) is "0".

(5) If entry (5) is less than 3, change entry (5) to "3".

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- ☒ Check enclosed as payment.
- ☐ Charge "TOTAL FEES DUE" to the Deposit Account No. below.
- ☐ No payment is enclosed and no charges to the Deposit Account are authorized at this time (unless specifically required to obtain a filing date).

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- ☒ If the above-noted "AMOUNT ENCLOSED" is not correct, the Commissioner is hereby authorized to credit any overpayment or charge any additional fees necessary to:
- Deposit Account No. 19-3935
- Deposit Account Name STAAS & HALSEY LLP
- ☒ The Commissioner is also authorized to credit any overpayments or charge any additional fees required under 37 CFR 1.16 (filing fees) or 37 CFR 1.17 (processing fees) during the prosecution of this application, including any related application(s) claiming benefit hereof pursuant to 35 USC § 120 (e.g., continuations/divisionals/CIPs under 37 CFR 1.53(b) and/or continuations/divisionals/CPAs under 37 CFR 1.53(d)) to maintain pendency hereof or of any such related application.

SUBMITTED BY: STAAS & HALSEY LLP

Typed Name Stephen T. Boughner

Reg. No. 45,317

Signature

Date

8/22/05

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